



PATENT
Customer No. 22,852
Attorney Docket No. 3626.0034-05

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Bruce E. NOVICH et al.)	Group Art Unit: 1774
)	
Application No.: 09/620,525)	Examiner: Jill M. Gray
)	
Filed: July 20, 2000)	Confirmation No.: 2888
)	
For: IMPREGNATED GLASS FIBER)	
STRANDS AND PRODUCTS)	
INCLUDING THE SAME)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR RECONSIDERATION

Further to the Notice of Appeal filed October 26, 2004, and in response to the final Office Action mailed April 26, 2004, and the Advisory Action mailed November 17, 2004, the period for response having been extended to March 28, 2005, by a request for extension of three months and fee payment filed concurrently herewith, favorable reconsideration of this application in light of the following discussion is respectfully requested.

I. STATUS OF THE CLAIMS

Upon entry of the Amendment filed October 26, 2004, claims 1 and 5-63 are currently pending in this application. Claims 9-12, 15-17 and 33-63 have been withdrawn. Claims 1, 4-8, 13, 14 and 18-32 were rejected in the Office Action dated April 26, 2004. No claim has been allowed.

II. REJECTION UNDER 35 U.S.C. § 103(a)

The Examiner maintains the rejections of claims 1, 4-8, 13, 14 and 18-32 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,340,519 to Kotera et al. ("*Kotera*") in view of U.S. Patent No. 6,139,958 to Raghupathi et al. ("*Raghupathi*"). Applicants maintain that a prima facie case of obviousness has not been established because the Examiner has not shown that *Kotera* and *Raghupathi*, in combination, meet the requirements for a rejection under Section 103(a).

A. Claims 1, 5-8, 13, 14 and 18-32

In this case, the Examiner fails to present substantial evidence on the three prongs necessary for a proper rejection under Section 103(a). First, neither the proposed combination of *Kotera* and *Raghupathi*, nor the evidence of the knowledge of one skilled in the art, teaches or suggests all the claim limitations. Second, there is no evidence of a suggestion or motivation that would prompt a person of ordinary skill in the art to combine *Kotera* and *Raghupathi*. Third, there is no evidence of a reasonable expectation of success that would result from a person of ordinary skill in the art combining *Kotera* and *Raghupathi*.

1. The Rejection Should Be Reversed Because The Prior Art Does Not Teach Or Suggest The Limitations Of Claim 1 And There Is No Evidence That The Missing Limitation Is Within The Knowledge Of One Of Ordinary Skill In The Art.

First, Applicants respectfully submit that the rejection under § 103 is fatally flawed because neither *Kotera* nor *Raghupathi*, nor combination of the two, teach all of the limitations of claim 1 and claims 5-8, 13, 14 and 18-32, which depend therefrom.

Claim 1 recites a fabric comprising, inter alia, at least one fiber strand comprising at least one glass fiber. Conspicuously absent from the disclosure in *Kotera*, however, is any mention of a fabric comprising at least one glass fiber. Indeed, the Examiner acknowledges this fact by stating that “*Kotera* does not specifically teach glass fibers.” Final Office Action dated April 26, 2004, at 4.

Nothing in *Raghupathi* corrects the deficiencies of *Kotera*. *Raghupathi* expressly teaches chemically treated glass fibers that are used to reinforce thermosetting polymer matrices by **dispersing** the **individual**, chopped glass fiber strands “somewhat uniformly over the polymeric matrix.” *Raghupathi*, col. 9, lines 17-19 (emphasis added). The dispersed glass fibers then “settle and become wet-out in the polymeric matrix.” *Id.* This process is repeated in *Raghupathi*’s examples. See *id.*, col. 11, lines 4-7. Such a teaching in *Raghupathi* clearly indicates that a woven fabric comprising at least one fiber strand comprising at least one glass fiber as presently claimed is not utilized in reinforcing the polymer matrices, since the individual, chopped fibers are simply distributed over the matrix material as opposed to woven into a fabric. As a result, *Raghupathi* also fails to teach a fiber strand comprising at least one glass fiber .

Accordingly, both *Kotera* and *Raghupathi* fail to teach all the present claim elements. Accordingly, Applicants respectfully submit that this rejection is improper and request withdrawal of this rejection, and allowance of claims 1, 5-8, 13, 14 and 18-32.

2. The Rejection Should Be Reversed Because Neither The Prior Art Nor The Knowledge Generally Available To One Of Ordinary Skill In The Art Provides The Requisite Suggestion Or Motivation To Combine *Kotera* And *Raghupathi*

The Federal Circuit has noted that the Examiner's burden to establish a motivation to combine or modify is provided by an objective teaching found in the prior art. The Examiner's factual findings regarding the motivation to combine or modify must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Examiner fails to set forth such "clear and particular" evidence here.

a *The Examiner's Failure To Present Evidence Of Motivation Dictates Dismissal Of The Examiner's Rejection*

Although the Examiner claims that, when combined, *Kotera* and *Raghupathi* disclose the present invention, the Examiner failed to make a factual inquiry based on the objective evidence of record. Such an inquiry reveals that there is no motivation to make the proposed combinations at the time the invention was made for at least the following reasons.

First, *Kotera* is drawn to preparing an aqueous dispersion of polyester resin, comprising a crystalline polyester, a non-crystalline polyester, a water-soluble organic compound and water. See *Kotera* at Abstract. *Raghupathi*, on the other hand, is drawn to a method of preparing chemically treated glass fibers, wherein the chemical treating composition comprises film forming polymers, organo coupling agents, a lubricant, a salt and water. See *Raghupathi* at Abstract and Summary of Invention.

Second, *Kotera* teaches that the resin can give a coating layer having excellent water resistance and weatherability (see, e.g., *Kotera* at Abstract and col. 2, lines 9-12), whereas the coating in *Raghupathi* is drawn to a coating that “enables a more facile wet-out” of the glass fibers. *Raghupathi* at col. 1, lines 15-18.

Third, *Kotera* is drawn to preparing a resin dispersion to treat plastic and glass products, such as “horticultural house, materials for window, lens, or the like.” *Kotera* at col. 9, lines 45-47. *Raghupathi*, on the other hand, is drawn to preparing fiber reinforced polymer panels. *Raghupathi* at col. 1, lines 17-18. Unlike the Examiner’s allegation at page 4 of the April 26, 2004, final Office Action, *Kotera* does *not* specifically indicate that a suitable plastic or glass product is a panel. Such a use is not taught or implied by *Kotera*.

Kotera and *Raghupathi* are therefore directed to the use of **different** chemicals in **different** methods for **different** purposes to obtain **different** products. Applicants therefore submit that one of ordinary skill in the art reading these two references would not have been motivated to combine their divergent teachings as proposed by the Examiner. Accordingly, for at least this reason, Applicants submit that the Examiner has failed to demonstrate a prima facie case of obviousness.

b. *The References Teach Away From The Examiner's Proposed Combination*

It is well-settled that claims are not obvious if the cited reference or other relevant art teaches away from the claimed invention. M.P.E.P. § 2145(X)(D)(1).

In the present case, *Kotera* and *Raghupathi* expressly teach away from their combination. Central to the invention disclosed in *Kotera* is a polyester resin that is utilized “for various utilities such as coating compositions, laminated products, aqueous printing ink, aqueous binder for coating, and surface treating agent for giving drip-proof.” *Kotera*, col. 2, lines 15-20. Indeed, *Kotera* expressly teaches that the resin gives “a coating film having excellent water resistance and excellent weatherability.” See, e.g., *id.*, col. 1, lines 7-8; col. 2, lines 11-15; col 7, lines 47-48. The potential uses of the polyester resin disclosed in *Kotera* and all the Examples found in *Kotera* further support this fact. Such language clearly indicates that the resin acts as an external coating for a finished object.

An examination of the entire disclosure in *Raghupathi*, however, leads one of skill in the art away from a combination with *Kotera*. As discussed above, *Raghupathi* discloses coated glass fibers that are distributed somewhat uniformly over a polymeric matrix. *Raghupathi*, col. 11, lines 17-19. The dispersed glass fibers then become effectively embedded within the polymeric material in which they are incorporated, with little or no contact with any external surfaces. *Id*; see also *id.*, col. 11, lines 4-7. Such a teaching in *Raghupathi* clearly would lead one skilled in the art away from the combination of this reference with *Kotera*, where the claimed polyester resin is utilized on external surfaces. For at least this reason, the teachings of *Kotera* and *Raghupathi* cannot be combined in the manner proposed by the Examiner.

3. There Is No Evidence Of A Reasonable Expectation Of Success

In addition to showing a motivation to modify/combine the prior art references to make the claimed invention, the Examiner must show why a person of ordinary skill in the art would have had a reasonable expectation of success for such a modification/combination. See, e.g., M.P.E.P. §2143.02.

In the present case, the Examiner has not presented evidence that the teachings of *Kotera* and *Raghupathi* would have provided one of ordinary skill in the art with a reasonable expectation of success in making the present invention. Rather, the Examiner remains silent as to how the teachings of either reference would suggest such an expectation. Since the Examiner has not provided *any* justification or support for such an expectation, Applicants submit that the Examiner has failed in the duty to adequately show reasonable expectation of success. As a result, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, and as a result, has not met the burden for establishing obviousness. Applicants respectfully request that the Section 103 rejection of claims 1, 5-8, 13, 14 and 18-32 be withdrawn.

B. Claims 18 and 19

As with independent claim 1, the Examiner has not met the burden for establishing a prima facie case of obviousness for claims 18 and 19. Specifically, in regard to claim 18, the Examiner states that “the particles *necessarily* provide some degree of interstitial spacing.” Office Action dated October 27, 2003, at 5 (emphasis

added). The Examiner further rejects claim 19 by asserting that "this claim is drawn to the size of the particles, wherein size is *not ordinarily* a matter of invention." *Id.* In making such rejections, the Examiner does not cite to any supporting documentary evidence, either from the record or from statutory sources, and, instead, makes broad, conclusory statements which require one of ordinary skill in the art to make unwarranted assumptions about interstitial spacing and the size of the claimed particles. However, the Federal Circuit has stated that "[m]ere . . . conclusory statements . . . are not sufficient to establish a genuine issue of material fact." *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed.Cir.1993). Since the Examiner has not provided *any* justification or support for such arguments, Applicants submit that the Examiner has failed in the duty to adequately support the Examiner's conclusion. See M.P.E.P. § 2144.03; *see also In re Ahlert*, 424 F.2d at 1091.

Thus, for at least the foregoing reasons, Applicants respectfully submit that the Examiner has failed to make a prima facie showing of obviousness. Accordingly, the rejection under 35 U.S.C. § 103 is in error and should be withdrawn.

III. **CONCLUSION**


In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: March 28, 2005

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